

## REMARKS

The Examiner is thanked for the very thorough and professional Office Action. Pursuant to that Office Action, Claims 1, 10, 12 and 18-21 have been amended to more definitely set forth the invention and obviate the rejection. Support for the amendment of Claim 1 can be found in the Specification on page 27, lines 16-25, and page 28, lines 1 and 2, and on page 32, lines 1-7. The present amendment is deemed not to introduce new matter. Claims 1, 3, 5-8 and 10-21 remain in the application.

At the outset, it is noted that an English translation of the cited references of JP 06080825, JP 06228248, and JP 08-325466 is submitted herewith in an Information Disclosure Statement.

Reconsideration is respectfully requested of the rejection of Claims 1, 3, 6-8, 10, 11 and 13-21 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over J-63-13969 (hereinafter the '969 reference), and the rejection of Claims 1, 3, 5-8, and 10-21 under 35 U.S.C. § 103(a) as being unpatentable over EP 0035049 (hereinafter the '049 in view of J-55-036241 (hereinafter '241).

It is respectfully submitted that the claims now in the case clearly distinguish from the '969, '049 and '241 references since none of these references disclose the particular composition now called for in the claims herein. As for the '969 reference, it is respectfully submitted that this reference does not disclose the compound A containing the hydrolysable epoxy group as stated by the Examiner. As can be seen from the English translation of the abstract, the compound A contains a mere epoxy group. Applicants cannot find any recitation in the '969 reference of the use of a hydrolysable epoxy group. At any rate, the claims have been amended to call for a compound A having at least two hydrolysable silyl groups in a molecule, and the present amendment now sets

forth the amount of the constituents in the adhesive composition. With these amendments, it is believed that the claims now in the application clearly distinguish from the '969, '049, and the '241 references.

Moreover, the '241 reference discloses a curable composition of an organic polymer including hydrolysable silicone containing group and photocurable material. In the '241 reference, the photocurable material can react on only a portion of the material where light is irradiated, namely, the surface of the sealant, which is described on page 2 of the '241 reference. However, the present invention as called for in the claims herein contains a photoinitiator.

Further, the '049 reference describes on page 2, line 8, that , "The photocurable substance will react only in those areas which are exposed to light such as the exterior surface or interface of sealant with glass". Accordingly, both the '241 and '049 references disclose that the photocurable material will react only on the surface irradiated.

In contrast, the present inventive composition can be cured not only on the surface but also in its inner portion since the composition contains a photoinitiator and utilizes photo-cation polymerization mechanisms. It is respectfully submitted that neither the '241 nor the '049 references disclose such a feature as called for in the claims herein since these prior art compositions usually utilize radical polymerization mechanisms.

For these reasons, it is respectfully submitted that the '969 reference fails to anticipate or render unpatentably obvious the subject matter now called for in the claims. Further, it is also respectfully submitted that the '049 reference taken with the '241 references neither anticipates nor renders unpatentably obvious the subject matter called for in the claims herein for the reasons set forth above.

Additionally, there is no teaching or suggestion in either of these references that they could be combined in the manner suggested by the Examiner. But even if they were, one of ordinary skill in the art would not arrive at the invention as now called for in the claims herein. Consequently, the Examiner would be justified in no longer maintaining these rejections. Withdrawal of the rejections is accordingly respectfully requested.

Reconsideration is respectfully requested of the rejection of Claims 1, 3, 6-8, 10, 11 and 13-21 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over J 06080825 (hereinafter ‘825).

The adhesive composition according to the ‘825 reference is rapidly cured by both a photocuring mechanism and a moisture curing mechanism. As can be seen from Examples 1-3 of the ‘825 reference (English translation of same being filed in an IDS herewith), the adhesive strength and elongation of the tape is approximately the same between the composition immediately after photoradiation and the final composition cured with moisture (see Table 1 on page 12 of the English translation of the ‘825 reference).

Example 1 shows an elongation of 120% and a strength of 2.0 kgf/cm<sup>2</sup> in the moisture-cured product, while the elongation is 100% and the strength is 2.5 kgf/cm<sup>2</sup> in the ultraviolet-cured product. Accordingly, in the composition of the ‘825 reference the cured composition obtained by the reaction of the photocurable component due to irradiation reveals approximately the same mechanical properties of the finally cured composition.

In contrast, curing according to the present invention is only slowly occurring as indicated by the low conversion ratio after irradiation. As stated in Claim 1, the conversion of (A) and (C) immediately after exposure is merely 10-70% while the conversion of up to 100% is achieved only

after 24 hours. Thus, it can be seen that the adhesive composition according to the '825 reference fails to have the specific properties of the composition of the present invention. For these reasons, it is respectfully submitted that the claims as amended herein are neither anticipated by nor unpatentable obvious over the '825 reference. Consequently, the Examiner would be justified in no longer maintaining this rejection. Withdrawal of the rejection is accordingly respectfully requested.

Reconsideration is respectfully requested of the rejection of Claims 1, 3, 6-8, 10, 11, and 13-21 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over J 06-228248 (hereinafter '248 reference).

The '248 reference, (the English translation of which is being filed in an IDS herewith) like the '825 reference discussed above, fails to disclose a composition having the feature of gradually curing, together with a low conversion ratio as one of the essential features according to the present invention. Therefore, and especially in view of the amendments herein of the claims, it is respectfully submitted that the '248 reference neither anticipates nor renders unpatentably obvious the subject matter of the claims herein. For these reasons, it is respectfully submitted that the Examiner would be justified in no longer maintaining the rejection. Withdrawal of the rejection is accordingly respectfully requested.

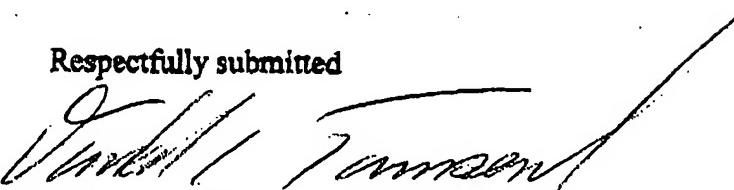
Reconsideration is respectfully requested of the rejection of Claims 1, 3, 6-8, 10, 11 and 13-21 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over J 08-325466 (herein after '466 reference).

In the '466 reference (an English translation of which is being filed in an IDS herewith) the composition disclosed therein contains a large amount of calcium carbonate as a filler. Thus, the feature of gradually curing after irradiation/exposure, wherein also the inner portion is fully cured

due to continuing of the curing reaction, cannot be obtained in accordance with the disclosure of the '466 reference. For this reason, and in view of the amendments to the claims herein, it is respectfully submitted that the '466 reference neither anticipates nor renders unpatentably obvious the subject matter now called for in the claims herein. Therefore, the Examiner would be justified in no longer maintaining this rejection. Withdrawal of the rejection is accordingly respectfully requested.

In view of the foregoing, it is respectfully submitted that the application is now in condition for allowance and early action and allowance thereof is accordingly respectfully requested. In the event there is any reason why the application cannot be allowed at the present time, it is respectfully requested that the Examiner contact the undersigned at the number listed below to resolve any problems.

Respectfully submitted



Donald E. Townsend  
Reg. No. 22,069

**Customer No. 27955**

Date: January 17, 2005

TOWNSEND & BANTA  
601 Pennsylvania Ave., N.W.  
Suite 900, South Building  
Washington, D.C. 20004  
(202) 220-3124

**CERTIFICATE OF MAILING**

I hereby certify that this Amendment and Transmittal in Docket No. M&M-048-USA-PCT, Serial No. 10/019,433, filed December 31, 2001 was deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

On January 17, 2005

Donald E. Townsend

